

REMARKS

This amendment is in response to the Office Action of July 11, 2007 in which claims 1, 4, 10, 11, 29, 32, 38, 39 and 57-62 were rejected.

Various of the previously presented claims are changed in ways believed related only to matters of form. For example, reference numerals/labels are removed from the claims, which change does not affect the scope of the claims per MPEP § 608.01(m) (the use of reference characters is considered as having no effect on the scope of the claims). Also, the claims are amended to remove "step of" language.

Claims 1 and 29 are objected for lack of antecedent basis. The applicant corrected antecedent basis for the "predetermined parameter", but does not recognize any problem with the antecedent basis for the "predetermined range". Explanations are requested from the Office.

Claims 1, 10, 29, 38, 58 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Fiorini et al. (US Patent No. 6760596). The applicant believes that the Examiner's statements are not accurate in regard to several claims and need further clarification.

The Examiner's arguments are analyzed based on MPEP guidelines which are stated in the MPEP Paragraph 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. Further, "the identical invention must be

shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

The applicant disagrees with rejection of claims 10 and 38 over Fiorini et al. because Fiorini et al. state (see col. 2, lines 20-25) that increasing a spreading factor will decrease the C/I level required to ensure a desired FER or BLER. This is a general and obvious statement which is well known to a person skilled in the art. However, this statement does not disclose the specific limitation of claims 10 and 38 of the present invention which state that "said changing the spreading factor is carried out only if said frame or block error rate meets a selected criterion", contrary to what is alleged by the Examiner.

Thus, Fiorini et al. do not teach all claim limitations of claims 10 and 38 of the present invention required by the MPEP Rule 2131 quoted above, therefore, claims 10 and 38 are novel and is not anticipated by Fiorini et al. under 35 USC Section 102(e).

Claims 1 and 29 are amended to incorporate the above limitation "wherein said changing the spreading factor is carried out only if said frame or block error rate meets a selected criterion" which separates these claims from the prior art of Fiorini et al. quoted by the Examiner.

The novelty of amended claims 10 and 38, and claims 58 and 61 is provided by the novelty of amended claims 1 and 29 under 35 U.S.C. 102(e) as being anticipated by Fiorini et al.

Claims 4, 11, 32, 39, 57, 59, 60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over under 35 U.S.C. 102(e) as being anticipated by Fiorini et al. (US Patent No. 6760596) in view of Andersson et al. (U.S. Patent No.: 6,334,047).

First, the novelty and non-obviousness of dependent claims 4, 11, 32, 39, 57, 59, 60 and 62 is provided by the novelty and

non-obviousness of amended independent claims 1 and 29 under 35 U.S.C. 102(e), as shown above (claims 4, 11, 32, 39, 57, 59, 60 and 62 are dependent claims of claims 1 and 29).

In addition, claims 4, 11, 32 and 39 comprise unique limitations such that the Examiner's interpretation of the quoted references needs further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

For example, the Examiner uses a reference of Andersson et al. to combine with Fiorini et al. to arrive at the subject matter of claims 4, 11, 32 and 39 of the present invention. The difference with claims 4, 11, 32 and 39 is that Anderson provides power instructions using well known in the art traffic power control (TPC) command (see col. 9, lines 18-24 of Andersson et al.), whereas according to claims 4, 11, 32 and 39 of the present invention this TPC signal comprises a change in the spreading factor which is not disclosed by Anresson et al., contrary to what is alleged by the Examiner. Therefore, incorporating disclosure of Andersson et al. into Fiorini et al. will teach away from the teaching of Fiorini et al. and from teaching of the embodiments of the present invention recited in claims 4, 11, 32

and 39.

Thus, none of the reference quoted by the Examiner disclose unique limitations of claims 4, 11, 39, 57, 59, 60 and 62 (in addition to being dependent on novel amended claims 1 and 29, as argued above) of the present invention which is required by the MPEP paragraph 2143.

In addition in regard to claims 4, 11, 32, 39, 57, 59, 60 and 62 of the present invention, the Office failed to show prima facie case of obviousness and demonstrate or provide any reasonable arguments in regard to "suggested desirability or motivation" or "reasonable expectation of success" for combining references by a person skilled in the art at the time of the invention without the benefit of hindsight (assuming for sake of argument only that quoted references teach or suggests all the limitations of independent claims 4, 11, 32, 39, 57, 59, 60 and 62), as required by MPEP paragraphs 2143 (quoted above) and 2142, and by an extensive case law on the subject.

If only for the sake of argument we assume that Fiorini et al. and Andersson et al. teach or suggest all the limitations of claims 4, 11, 32, 39, 57, 59, 60 and 62 (contrary to what is stated above), there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by Fiorini et al. and Andersson et al. generally available to one of ordinary skill in the art to incorporate Andersson et al. into Fiorini et al. to arrive at the subject matter of claim 4, 11, 32, 39, 57, 59, 60 and 62 of the present invention (as required by the MPEP Paragraph 2143 referenced above and by the case law) without the benefit of hindsight. (the Examiner did not proof otherwise, but the Examiner bears a burden of proof as stated in MPEP Paragraph 2142.)

Moreover, in regard to claims 4, 11, 32, 39, 57, 59, 60 and 62 of the present invention, the Examiner alleged that a person

skilled in the art at the time of invention would be motivated to incorporate the reference of Andersson et al. into Fiorini et al. (which actually will teach away from the subject matter of independent claims 1 and 29 as shown above) in order to provide, e.g., "transmitting a transmit power control command" or "setting one reference SNR", etc. In other words, the Examiner's reasoning (e.g., "to transmit a transmit power control command" or "setting one reference SNR") for incorporating Andersson et al. into Fiorini et al. to arrive at the subject matter of claims 4, 11, 32, 39, 57, 59, 60 and 62 is practically similar to "shared advantage" approach such as achieving competitive advantage or economical advantage (which can make any invention obvious) irrelevant to the "problem to be solved" by the present invention, e.g., adapting spreading factor based on the power control facilitated by the power control command".

The Manual of Patent Examining Procedure (the MPEP) clearly refers to the "problem to be solved" approach and cites a relatively recent Federal Circuit case supporting its use: "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). MPEP 2143.01.

Thus, based on all above arguments, claims 4, 11, 32, 39, 57, 59, 60 and 62 are not obvious under 35 U.S.C. 103(a) as

being anticipated by Fiorini et al. in view of Andersson et al.

The rejections of the Official Action of July 11, 2007, having been obviated by this amendment or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is solicited.

Respectfully submitted,

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